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EXAMINER

SCHLAK, DANIEL K

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/652,709

Applicant(s)

AVANT ET AL.

Examiner

Daniel K Schlak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-158 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-158 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, 77-82, and 91-96, drawn to sorting a single mailpiece with determination of markings on reverse and obverse, classified in class 209, subclass 584.
- II. Claims 105-122, drawn to document processing and construction of files, classified in class 707, subclass 500.
- III. Claims 123-132, drawn to image analysis, classified in class 382, subclass 102.
- IV. Claims 133-148, drawn to image storage/retrieval, classified in class 369, subclasses 18 and/or 13.
- V. Claims 149-158, drawn to creating a file with external input of data, classified in class 707, subclass 500 and/or subsequent subclasses.
- VI. Claims 9-18, 83-90, and 97-104, drawn to sorting multiple mailpiece each having a marking in a different location and one mailpiece with no marking, classified in class 700, subclass 224.
- VII. Claims 19-30 and 45-59, drawn to sorting a mailpiece with file creation and transportation of data with keying, classified in class 382, subclass 100.

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VIII. Claims 31-44 and 60-76, drawn to sorting multiple mailpieces with image component, transporting component, keying, and ID file transmission with associating, classified in class 382, subclass 100.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and (III, IV, V) are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because all three of the subcombinations (groups III, IV, and V) deal with detailed manipulation of the so-called file. Group I does not require comparing the images (Group III). Group I does not require storing the images and/or receiving a prompt (Group IV). Group I does not require presenting a file or data to an operator (Group V). The subcombination has separate utility such as creating files without comparing to master tables, without receiving prompts, and without presenting to an operator. The "creating ID file" of group I could be simply creating a facsimile copy of one of the markings, which does not require the specifics of any of the other groups.

Inventions VI and (III, IV, V) are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for

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patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because all three of the subcombinations (groups III, IV, and V) deal with detailed manipulation of the so-called file. Group VI does not require comparing the images (Group III). Group VI does not require storing the images and/or receiving a prompt (Group IV). Group VI does not require presenting a file or data to an operator (Group V). The subcombination has separate utility such as creating files without comparing to master tables, without receiving prompts, and without presenting to an operator. The "creating ID file" of group VI could be simply creating a facsimile copy of one of the markings, which does not require the specifics of any of the other groups.

Inventions VII and (III, IV, V) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because all three of the subcombinations (groups III, IV, and V) deal with detailed manipulation of the so-called file. Group VII does not require comparing the images (Group III). Group VII does not require storing the images and/or receiving a prompt (Group IV). Group VII does not require presenting a file or data to an operator (Group V). The subcombination

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has separate utility such as creating files without comparing to master tables, without receiving prompts, and without presenting to an operator.

Inventions VIII and (III, IV, V) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because all three of the subcombinations (groups III, IV, and V) deal with detailed manipulation of the so-called file. Group VIII does not require comparing the images (Group III). Group VIII does not require receiving a prompt (Group IV). Group VIII does not require presenting a file or data to an operator (Group V). The subcombination has separate utility such as creating files without comparing to master tables, without receiving prompts, and without presenting to an operator.

Inventions II and (III, IV) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group II does not require storing the images and/or receiving a prompt (Group IV), and it does not require presenting a file or data to an operator (Group V). The subcombination has

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separate utility such as receiving OCR data, which is not explicitly provided for in the subcombinations.

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as sorting on a front code. Invention I has separate utility such as sorting on a back code. Invention II has separate utility such as transmitting to a keying site and receiving OCR data. See MPEP § 806.05(d).

Inventions VI and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VI has separate utility such as sorting on a front code. Invention VI has separate utility such as sorting on a back code. Invention II has separate utility such as transmitting to a keying site and receiving OCR data. See MPEP § 806.05(d).

Inventions VII and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VII has separate utility such as sorting on a front code. Invention VII has separate utility such as sorting on a back code. Invention II has separate utility such as transmitting to a keying site and receiving OCR data. See MPEP § 806.05(d).

Inventions VIII and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if

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they are shown to be separately usable. In the instant case, invention VIII has separate utility such as sorting on a front code. Invention VIII has separate utility such as sorting on a back code. Invention II has separate utility such as transmitting to a keying site and receiving OCR data. See MPEP § 806.05(d).

Inventions III and (IV, V) are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as comparing images and receiving master reference tables. Invention IV has a separate utility such as receiving a prompt, not included in group III. Invention V has a separate utility such as presenting to an operator, not included in group III. See MPEP § 806.05(d).

Inventions IV and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as receiving a prompt or storing an image. Invention V has a separate utility such as creating a file based on operator presentation. See MPEP § 806.05(d).

Inventions I and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as determining if there are codes on front and back of the same mailpiece. Invention VI has separate utility such as processing a second mailpiece. See MPEP § 806.05(d).

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Inventions I and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as applying a postal code to the front of the mailpiece. Invention VII has separate utility such as having a provision for keying. See MPEP § 806.05(d).

Inventions I and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as determining if there are codes on front and back of the same mailpiece. Invention VIII has separate utility such as having a provision for keying. See MPEP § 806.05(d).

Inventions VI and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VI has separate utility such as processing a second mailpiece. Invention VII has separate utility such as determining whether there are codes on the front and back of a single mailpiece. See MPEP § 806.05(d).

Inventions VI and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VI has separate utility such as applying a postal code to the front of a mailpiece. Invention VIII has separate utility such as having a provision for keying. See MPEP § 806.05(d).

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Inventions VII and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VII has separate utility such as determining whether there are codes on front and back of a single mailpiece. Invention VIII has separate utility such as processing a second mailpiece. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for any of groups I, VI, VII, and VIII, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group III is not required for any of the other groups, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group IV is not required for any of the other groups, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group V is not required for any of groups I, III, and IV, restriction for examination purposes as indicated is proper.

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Because these inventions are distinct for the reasons given above and the search required for Group VI is not required in whole for any of groups I, VII, and VIII, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group VII is not required in whole for any of groups I, VI, and VIII, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group VIII is not required for any of groups I, VII, and VII, restriction for examination purposes as indicated is proper.

Corresponding to groups II and V, which are shown to have the same primary classification, it is the examiner's opinion that, even though these groups may fall into similar classifications, and possibly incur overlapping searches, a serious burden is being imposed on the examiner by the recitation of the receipt of OCR data in the independent claims of group II. This alone invokes several subclasses which are not specific to file manipulation based upon the operator. Further, the independent claims of group II never specifically mention what a keying site is, insofar as it would necessarily require presentation to an operator. Further still, the conditional provision of "creating an ID file *when it is not already present*" is a second echelon subcombination itself which fully distinguishes the combination from the subcombination.

Although groups VII and VIII are similarly classified, it is stressed that there is quite a distinction between a process for performing multiple tasks on a single item and a process for performing single task on multiple items. Although the searches and

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classification will be similar, the burden on the Examiner will reside in what exactly he focuses on within the search. Further, regardless of the burden on the Examiner, the processes are so inherently disjunct so as to require being covered by separate patents.

Original Group I, claims 1-104, has been further broken up into Groups I, VI, VII, and VIII, due to the amendments to the claims which have resulted in four distinct inventions, none of which can be drawn to any of original Groups II, III, IV, and V.

Above it has been shown how these groups are separate from each other and from the originally presented groups. As the restriction requirement is put anew, the old groups which were not elected have been brought back into consideration so that, if Applicant so chooses, Applicant may elect any of the eight groups.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

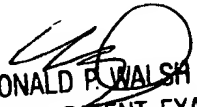
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 306 - 4173. The fax phone numbers for the organization where this application or proceeding is assigned are 703-306-4195 for regular communications and 703-306-4195 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308 - 1113.

dks
September 4, 2003


DONALD P. WALSH
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